

REMARKS

The Applicant has filed the present Amendment and Response in reply to the outstanding Official Action of January 29, 2007, and the Applicant believes the Amendment and Response to be fully responsive to the Official Action for at least the reasons set forth below in greater detail.

At the onset, Applicant would like to thank the Examiner for indicating that Claims 12 and 13 are allowed and Claim 6 has allowable subject matter.

Additionally, Applicant notes that new Claims 14-16 have been added to the application for examination. The subject matter of Claims 14-16 is similar to the subject matter of allowed Claims 6, 12 and 13. However, the limitation of “resistor connected between a connecting point between said inductor and said variable capacitor and said output terminal” has been deleted from the new claims. No new matter has been added by the aforementioned claim amendments.

Applicant submits that all of the claims are patentably distinct from the cited reference.

In the outstanding Official Action, Claims 1-5 and 7-11 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over Segawa.

Applicant respectfully disagrees with the rejections and traverses with at least the following analysis. Applicant submits that it is not obvious to use a variable capacitor to vary the resonant frequency of an amplifying circuit, as recited in the independent claims. The Examiner avers that it is well-known in the art to use a variable capacitor to vary the resonant frequency in a amplifying circuit. However, the Examiner failed to cite a reference that teaches using a variable capacitor to vary the resonant frequency in an amplifying circuit. Furthermore, the Examiner failed to state a motivation to modify Segawa from using a variable inductor to a variable capacitor. It has been held by the courts that to establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference. See In re Rouffet, 149 F.3d

1350, 1355, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). The absence of such a suggestion to combine is dispositive in an obviousness determination. See *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579 , 42 USPQ2d 1378, 1383 (Fed. Cir. 1997). “The showing of a motivation to combine must be clear and particular, and it must be supported by actual evidence.” *Teleflex, Inc. v. Ficosa North American Corp.*, 299 F.3d 1313, 63 USPQ2d 1374 (Fed. Cir. 2002) (Citing *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)).

The Examiner also states that using a variable capacitor would be an obvious substitution. Applicant respectfully disagrees; the Examiner’s conclusion is both legally and factually without merit. The Examiner is using an improper “obvious to try” rationale.

Obvious to try is not the standard under § 103. Using the Examiner’s logic, it would be obvious to try to modify each element of the circuit as long as the functionality would stay the same. Clearly, in an RLC circuit, the resistance of the resistor can be varied, the capacitance of the capacitor can be varied, and the inductance of the inductor can be varied. Each variation may vary the frequency characteristics. However, Segawa only suggests varying the inductance of the inductor. Segawa does not give any indication of which parameter should be varied, except the inductance. Therefore, the Examiner has not established that it would be obvious to vary the capacitance of the capacitor to control the frequencies, i.e., using a variable capacitor.

Moreover, there is no technical support for the Examiner’s conclusion. An inductor and a capacitor are two different circuit elements that function in different manners, they are not substitutes for each other. Simply by substituting one for the other would require a redesign of the circuit. Since the proposed modification (by the Examiner) is not suggested by the references, and there is no motivation, the Examiner’s rejection is based upon improper hindsight.

Therefore, Applicant submits that the Examiner has failed to provide a *prima facie* case of obviousness with respect to independent Claims 1 and 5. Applicant further submits that Claims 2-4 and 7-11 are patentably distinct from the references based at least upon the above-identified analysis in view of their dependency, whether directly or indirectly, from Claims 1 and 5. New Claims 14-16 are patentable at least based upon the same reasons for patentability as allowed Claims 6, 12 and 13.

For all the foregoing reasons, the Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-5, and 7-11 pursuant to 35 U.S.C. § 102 (e). Applicant further respectfully requests that the Examiner allow Claims 14-16.

In conclusion, the Applicant believes that the above-identified application is in condition for allowance and henceforth respectfully solicits the Examiner to allow the application. If the Examiner believes a telephone conference might expedite the allowance of this application, the Applicant respectfully requests that the Examiner call the undersigned, Applicant's attorney, at the following telephone number: (516) 742-4343.

Respectfully submitted,



Seth Weinfeld
Registration No. 50,929

Scully, Scott, Murphy & Presser, P.C.
400 Garden City Plaza – Suite 300
Garden City, New York 11530
(516) 742-4343

SW:ae